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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/604,830

Filing Date: August 20, 2003

Appellant(s): HOWARD, FRANK

Gerhard P. Shipley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 1, 2005 appealing from the Office action mailed August 17, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct. Examiner notices that the appellant states that claims 1-19 are currently pending, and claims 1, 5, 8, 11, 13 and 17 are appealed. This implies the rejections for claims 2-4, 6-7, 9-10, 12, 14-16 and 18-19 are sustained.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. The following rejection is copied from the final office action mailed on August 17, 2005.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsiounis et al., U. S. Patent Application Publication No.: US 2001/0039535 A1.

As to claims 1 and 3-5, Tsiounis teaches a method of mediating a business transaction, the method comprising the steps of (abstract):

- (a) providing a transaction center to act as a third-party intermediary between a purchaser and a participating merchant (Fig. 1);
- (b) providing a card for use by the purchaser to make the payment, wherein the card is associated with a monetary value (paragraphs 24, 42-43 and Fig. 1);
- (c) electronically receiving at the transaction center order information from the purchaser, wherein the order information need not identify the purchaser (paragraphs 43, 96 and Fig. 1);

- (d) electronically receiving at the transaction center payment information from the purchaser, wherein the payment information is associated with the card need not identify the purchaser (paragraphs 24, 42-43, 96 and Figs. 1);
- (e) verifying the validity of the card, verifying the monetary value, and debiting the monetary value by an amount substantially equal to the payment (paragraph 52 and Fig. 1);
- (f) electronically forwarding the order information to the participating merchant and substantially simultaneously confirming payment to the participating merchant, wherein the identity of the purchaser can remain substantially anonymous with respect to both the third party intermediary and the participating merchant (paragraphs 52, 96 and Fig. 1).

As to claims 2 and 6, Tsiounis further teaches receiving an order confirmation from the participating merchant (paragraph 52 and Fig. 1); and forwarding the order confirmation to the purchaser (see page 10 claim 11).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsiounis et al., U. S. Patent Application Publication No.: US 2001/0039535 A1 in view of Barlow et al., U. S. Patent 6,038,551.

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As to claim 7, Tsiounis teaches an electronic card is used for conducting the business transaction (paragraph 42). Tsiounis does not specifically teach the card includes a storage medium for storing non-personal information including an encrypted authentication number for verifying a validity of the card, and for storing personal information including a name and a shipping address for the purchaser, and a selection mechanism for allowing the purchaser to selectively withhold or transmit the personal information stored on the card. However, Barlow teaches customizing information on an electronic card (column 13 lines 20-55 and Fig. 5), and the electronic card is used for conducting business transaction includes a storage medium for storing non-personal information and personal information, and a selection mechanism for allowing the purchaser to selectively withhold or transmit the personal information stored on the card (column 11 line 66 – column 12 line 14 and Fig. 3). Barlow does not specifically teach the non-personal information including an encrypted authentication number and the personal information including a name and a shipping address for the purchaser. It would have been obvious to one of ordinary skill in the art to allow the non-personal information in Barlow's teaching to include an encrypted authentication number and the personal information to include a name and a shipping address for the purchaser for better customizing the electronic card based on the user's needs. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the electronic card in Tsiounis' teaching to include the non-personal information, personal information, and the selection mechanism as taught by the

modified teaching of Barlow for allowing the electronic card user to better control his or her information related to the business transaction.

As to claim 8, Barlow further teaches the selection mechanism is a mechanical sliding switch provided on the card (column 7 lines 51-63).

As to claim 9, Tsiounis teaches the stored information further includes the monetary value associated with the card (paragraph 52).

As to claim 10, Tsiounis teaches wherein the card is associated with a remotely maintained account wherein is stored the monetary value associated with the card (paragraph 52 and Figs. 1, 3, 5-6).

As to claim 11, Tsiounis teaches a method of mediating a business transaction, the method comprising the steps of:

- (a) providing a transaction center to act as a third-party intermediary between a purchaser and a participating merchant (Fig. 1);
- (b) providing a card for use by the purchaser to make the payment, wherein the card is associated with a monetary (paragraphs 24, 42-43 and Fig. 1);
- (c) electronically receiving at the transaction center order information from a purchaser, wherein the order information does not identify the purchaser (paragraphs 43, 96 and Fig. 1);
- (d) electronically receiving at the transaction center payment information from the purchaser, wherein the payment information is associated with the card and wherein the payment information does not identify the purchaser (paragraphs 24, 42-43, 96 and Figs. 1);

- (e) verifying a validity of the card, verifying the monetary value, and debiting the monetary value by an amount substantially equal to the payment (paragraph 52 and Fig. 1);
- (f) electronically forwarding the order information to the participating merchant and substantially simultaneously confirming payment to the participating merchant (paragraph 52 and Fig. 1);
- (g) electronically receiving an order confirmation from the participating merchant (paragraph 52 and Fig. 1);
- (h) electronically forwarding the order confirmation to the purchaser, wherein the identity of the purchaser can remain substantially anonymous with respect to both the third-party intermediary and the participating merchant (see paragraph 96 and page 10 claim 11).

Tsiounis does not specifically teach the card includes a storage medium for storing non-personal information including an encrypted authentication number for verifying a validity of the card, and for storing personal information including a name and a shipping address for the purchaser, and a selection mechanism for allowing the purchaser to selectively withhold or transmit the personal information stored on the card. However, Barlow teaches customizing information on an electronic card (column 13 lines 20-55 and Fig. 5), and the electronic card is used for conducting business transaction includes a storage medium for storing non-personal information and personal information, and a selection mechanism for allowing the purchaser to selectively withhold or transmit the personal information stored on the card (column 11

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line 66 – column 12 line 14 and Fig. 3). Barlow does not specifically teach the non-personal information including an encrypted authentication number and the personal information including a name and a shipping address for the purchaser. It would have been obvious to one of ordinary skill in the art to allow the non-personal information in Barlow's teaching to include an encrypted authentication number and the personal information to include a name and a shipping address for the purchaser for better customizing the electronic card based on the user's needs. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the card in Tsiounis' teaching to include the non-personal information, personal information, and the selection mechanism as taught by the modified teaching of Barlow for allowing the electronic card user to better control his or her information related to the business transaction.

5. Claims 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barlow et al., U. S. Patent 6,038,551.

As to claims 12 and 16, Barlow teaches a card for use by a purchaser to affect payment during a business transaction, the card comprising a storage medium for storing non-personal information and personal information; and a selection mechanism for allowing the purchaser to selectively withhold or transmit the personal information stored on the card (column 11 line 66 – column 12 line 14 and column 13 lines 56-65 and Fig. 3). Barlow does not specifically teach the non-personal information including an encrypted authentication number and the personal information including a name and a shipping address for the purchaser. It would have been obvious to one of ordinary

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skill in the art to allow the non-personal information in Barlow's teaching to include an encrypted authentication number and the personal information to include a name and a shipping address for the purchaser for better customizing the electronic card based on the user's needs.

As to claims 13 and 17, Barlow further teaches the selection mechanism is a mechanical sliding switch provided on the card (column 7 lines 51-63).

As to claims 14 and 18, Barlow teaches the stored information further includes the monetary value associated with the card (Fig. 6).

As to claims 15 and 19, Barlow teaches wherein the card is associated with a remotely maintained account wherein is stored the monetary value associated with the card (Figs. 2, 5-6).

(10) Response to Argument

The appellant argues that Tsounis fails to teach "electronically receiving at the transaction center order information from the purchaser, wherein the order information need not identify the purchaser" as claimed in step (b) of claim 1 or step (c) of claim 5 [emphasis added]. Examiner respectfully disagrees because Tsounis teaches the purchaser sends transaction information to the trusted third party (paragraph 42 and Fig. 1), in which the transaction information corresponds to the order information and the trusted third party corresponds to the transaction center of the claim. The transaction information includes payment price, currency code, merchant ID, transaction ID, transaction date and time, and description of goods sold (paragraph 36). There is no indication in this citation that the transaction information includes the identity of the

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purchaser. The appellant argues that Tsounis expresses no concern with confidentiality of customer identity. Examiner disagrees because Tsounis explicitly states "If the customer desires full anonymity, for example, from all parties including the trusted third party, the customer may use other payment method..." (paragraph 96). Thus, Tsounis' transaction or order information received at the trusted third party from the purchaser does not include the identity of the purchaser.

The appellant argues that Tsounis fails to teach "electronically forwarding the order information to the participating merchant and substantially simultaneously confirming payment to the participating merchant" as claimed in step (e) of claim 1 or step (f) of claim 5. The arguments are based on the argument discussed above (see last paragraph); thus, the argument is reverse on the same basis. As emphasized, Tsounis clearly teaches this limitation at paragraphs 52.

The arguments presented by the appellant for claim 11 are identical to the arguments for claims 1 and 5 as discussed above; thus the arguments for claim 11 are reversed on the same basis as shown above.

In response to the appellant's arguments that Barlow fails to teach "a mechanical sliding switch provided on the card" as shown in the dependent claim 8, examiner respectfully disagrees. Barlow teaches an integrated circuit (IC) card stores various types of information. The IC card has a built-in microcontroller (MCU) and the MCU is a single wafer integrated circuit which is mounted on a plastic card (column 7 lines 29-37). The IC card can also be in the form of a floppy diskette (column 7 lines 43-45). When the IC card is slid or inserted in the card reader, information can be transferred to/from

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the IC card (column 7 lines 51-63). The "mechanical sliding switch provided on the card" of the appellant's claim corresponds the built-in microcontroller mounted in the IC card, or if the IC card is in the form of floppy diskette, the "mechanical sliding switch provided on the card" would correspond to the write-protection switch located in a corner of conventional floppy diskette.

The arguments presented by the appellant for the dependent claims 13 and 17 are identical to the arguments for claim 8 as discussed above; thus the arguments are reversed on the same basis as claim 8 shown above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mary Cheung



MARY D. CHEUNG
PRIMARY EXAMINER

Conferees:

James Trammell

Hyung Sough

